

Attorney Docket No.: UT-0033  
Inventors: Mujtaba and Rao  
Serial No.: 10/009,455  
Filing Date: April 19, 2002  
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#### REMARKS

Claims 1-8 are pending in the instant application. Claims 1-8 have been rejected. Claims 1 and 4 have been amended. Support for this amendment is provided in the specification at page 14, lines 15-18. Reconsideration is respectfully requested in light of these amendments and the following remarks.

#### I. Rejection of Claims 1-8 under 35 U.S.C. § 102(e)

Claims 1-8 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Rao et al. (U.S. Patent 6,361,996).

Applicants respectfully traverse this rejection.

It is respectfully pointed out that both the instant application and U.S. Patent 6,361,996 name Dr. Mahendra Rao as a co-inventor. Applicants are submitting a Declaration by Dr. Rao herewith which states that any invention relating to mouse lineage restricted precursor cells disclosed, but not claimed in U.S. Patent 6,361,996 was derived from his work. Thus, the invention is not "by another".

Accordingly, since disclosures in U.S. Patent 6,361,996 relevant to the instant claimed invention are not "by another", this reference is not a valid prior art reference under 35 U.S.C. 102(e) with respect to the instant application. Withdrawal of this rejection under 35 U.S.C. 102(e) is therefore respectfully requested.

amendments.

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## II. Rejection of Claims 1-8 under 35 U.S.C. § 102(b)

Claims 1 and 4 have been rejected under 35 U.S.C. 102(b) as being anticipated by Johe et al. The Examiner suggests that Johe teaches isolated mouse cells or embryonic mouse stem cells.

Applicants respectfully traverse this rejection.

At the outset, it is respectfully pointed out that rejected claims 1 and 4 are drawn either to mouse neuron-restricted precursor cells or mouse glial-restricted precursor cells. As made clear in teachings of the specification at page 10 and 12, by neuron-restricted precursors as claimed it is meant cells that differentiate into a heterogeneous population of neurons but do not differentiate into oligodendrocytes or astrocytes when grown under glial promoting conditions. As made clear in teachings of the specification at page 11 and 13, by glial-restricted precursor cells as claimed it is meant cells that differentiate into oligodendrocytes and two kinds of astrocytes but do not differentiate into neurons when grown under neuron promoting conditions.

In contrast, Johe et al. (U.S. Patent 5,753,506) describe a multipotential precursor cell that differentiates

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into neurons, astrocytes and oligodendrocytes upon culture in appropriate differentiation conditions. See Abstract of U.S. Patent 5,753,506.

Further, claims 1 and 4 are both drawn to isolated, pure cell populations derived from mouse neural tube at embryonic day 12.0 or mouse embryonic stem cells. As taught at page 14, lines 15-18, by the term "pure" as set forth in claims 1 and 4, it is meant a population of cells in which greater than 95% exhibit the same characteristics.

In contrast, Johe et al. teach a cell population isolated from the embryonic rat hippocampus, striatum or cortex which, as taught at col. 13, lines 23-26, is only approximately 70% pure.

In an earnest effort to advance the prosecution of this case and to further distinguish the instant invention from prior art references such as Johe et al., Applicants have amended the claims in accordance with teachings at page 14, lines 15-18 to state that the cells are greater than 95% pure.

Thus, since Johe et al. does not teach cells with the same restricted differentiation potential as claimed in claims 1 and 4, does not teach cells isolated from the same starting tissue as claimed in claims 1 and 4, and does not

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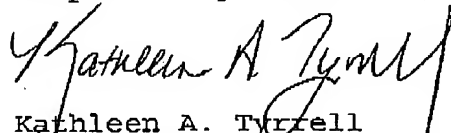
teach a cell population of the same purity as now claimed, this reference clearly does not teach all the elements of the instant claimed invention. Accordingly, this reference cannot anticipate the instant claimed invention. See MPEP 2131.

Withdrawal of this rejection under 35 U.S.C. § 102(b) is therefore respectfully requested.

### III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

  
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